

Appl. No. 09/917,320
Response Dated October 17, 2005
Reply to Office Action of June 16, 2005

REMARKS

Claims 1-20 stand in this application. Independent claims 1, 5, and 13 have been amended. No new matter has been added. The applicants respectfully request favorable reconsideration and allowance of the standing claims.

35 U.S.C. § 103

The Examiner rejected claims 1-9, 13-16, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,871,063 to Schiffer in view of United States Patent No. 6,633,759 to Kobayashi. The applicants respectfully traverse the rejection and request reconsideration and withdrawal of the obviousness rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

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As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. The applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 1-9, 13-16, 19, and 20. Therefore claims 1-9, 13-16, 19, and 20 define over Shiffer in view of Kobayashi whether taken alone or in combination.

For example, currently amended independent claim 1 recites the following language, in relevant part:

... reading a first network identifier associated with the first network environment and a port by the mobile device;
(emphasis added)

Currently amended independent claims 5 and 13 recite a similar element. The Examiner alleges that Schiffer column 4 lines 10-40 and element 210 of Fig. 2 teach reading a first network identifier associated with the first networking environment by the device. The applicants assert however that the cited portions of Schiffer disclose an access code generated by a mobile phone using data stored in the SIM. In particular, Schiffer column 4 lines 27-28 indicate that the "... data includes the subscriber identity number stored in the protected memory region of SIM 101." Schiffer column 4 lines 34-36 disclose that "... the access code may be an alternate value that may be encrypted using all or some portion of the subscriber identity number as an encryption key." The applicants assert that the identification mechanism described by Schiffer is an association between the subscriber identity number or other data particular to an individual SIM and a

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computer system. Accordingly, the cited portions of Schiffer do not teach a network identifier associated with the first network environment and a port as recited by currently amended independent claims 1, 5 and 13. The applicants therefore affirm that currently amended independent claims 1, 5, and 13 are patentable as each recites an element not taught by Schiffer in view of Kobayashi.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Dependent claims 2-4, 6-12, and 14-20 are therefore non-obvious and patentable over Schiffer in view of Kobayashi, taken alone or in combination, at least on the basis of their dependency from patentable currently amended independent claims 1, 5, and 13. Accordingly, the applicants respectfully requests that the Examiner remove the obviousness rejection with respect to all dependent claims.

CONCLUSION

For at least the foregoing reasons, the applicants submit that they have overcome the Examiner's rejections and that they have the right to claim the invention as set forth in the listed claims. The Examiner is invited to contact the undersigned at 360-696-8602 to discuss any matter concerning this application.

The applicants do not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, the applicants hereby reserve the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims

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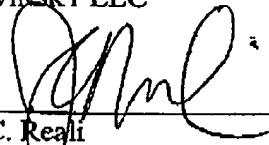
that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1-20 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,

KACVINSKY LLC



October 17, 2005
Dated

Jon C. Reali
Reg. No. 54,391
Under 37 C.F.R. § 1.34(a)

4500 Brooktree Road, Suite 102
Wexford, PA 15090
(724) 933-9390